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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/817,507 04/17/97 KISHIMOTO

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EXAMINER

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ART UNIT

PAPER NUMBER

1642

11

DATE MAILED:

12/07/98

Please find below and/or attached an Office communication concerning this application or  
proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/817,507**

Applicant(s)  
**Kishimoto et al**

Examiner  
**Julie E. Reeves, Ph.D.**

Group Art Unit  
**1642**



☒ Responsive to communication(s) filed on Oct 13, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire zero month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 15-28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 15-28 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. In response to the Office action mailed 5/13/98, Claims 1-14, drawn to a product, have been canceled and replaced with claims 15-28 directed at a method of treating a variety of diseases. Because the intended use of the product claims 1-14 carried no patentable weight, no restriction was needed between the product claims 1-14. However, in view of the newly submitted method claims, the methods for treating the different diseases does impart patentable weight. Accordingly, the claims present different inventions, as set forth below in the restriction requirement.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 16-18 and claims 15 and 24-28, in part, drawn to a method of treating plasmacytosis. If group I is elected, claims 15 and 24-28 will be examined to the extent that read up the method of treating *plasmacytosis*.

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Group II, claim(s) 19 and claims 15 and 24-28, in part, drawn to a method of treating hyperimmunoglobulinemia. If group II is elected, claims 15 and 24-28 will be examined to the extent that read up the method of treating hyperimmunoglobulinemia.

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Group III, claim(s) 20 and claims 15 and 24-28, in part, drawn to a method of treating anemia. If group III is elected, claims 15 and 24-28 will be examined to the extent that read up the method of treating anemia.

Group IV, claim(s) 21-22 and claims 15 and 24-28, in part, drawn to a method of treating nephritis or mesangium proliferative nephritis. If group IV is elected, claims 15 and 24-28 will be examined to the extent that read up the method of treating nephritis or mesangium proliferative nephritis.

Group V, claim(s) 23 and claims 15 and 24-28, in part, drawn to a method of treating cachexia. If group V is elected, claims 15 and 24-28 will be examined to the extent that read up the method of treating cachexia.

3. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the methods recite the treatment of different diseases. The methods of Inventions I-V differ in the method objectives, method steps and parameters and in the reagents used. Each of the diseases has a different pathological conditions, affect different organs of the body and result in different prognosis. The examination of all groups would require different searches in the U.S. PATENT shoes and the scientific literature and would require the consideration of different patentability issues. Thus Inventions I-V are separate and distinct in having different method steps and different endpoints and are do not relate to a single general inventive concept under PCT 13.1.

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4. A telephone call was made to Stephen Maebius on 29 Oct 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Reeves, Ph.D. whose telephone number is (703) 308-7553.



Julie E. Reeves, Ph.D.

October 29, 1998

**JULIE REEVES  
PATENT EXAMINER**